

**REMARKS/ARGUMENTS**

With entry of the amendment, claims 42-45, 48 and 51-54 are pending in this application. Claims 43 and 44 have been further amended to define the animal as a transgenic rodent model of Alzheimer's disease. Support is provided by *e.g.*, the paragraph bridging pp. 23-34 and p. 25, the first two complete paragraphs. Claim 48 is amended as suggested. Claims 1-41, 46, 47 and 53 were previously canceled. No new matter is added. Applicants reserve the right to pursue any canceled subject matter in a related, co-pending application.

The specification has been amended to recite the related applications from which priority is not being claimed at the end of the Background section.

Obviousness-Type Double Patenting

Claims 42-45, 48 and 51-54 remain rejected over all the allowed claims of US 6,284,211 in view of Vigo-Pelfrey et al. (of record) and Suzuki et al. (of record). The Examiner alleges that the instant claims are directed to an invention not patently distinct from the claims of commonly assigned US 6,284,211. The Examiner further alleges that it would have been obvious to modify the assay of US 6,284,211 by measuring the species of A $\beta$ (x>41) by means of the assay of Suzuki et al. because Vigo-Pelfrey et al. teach that A $\beta$ (1-42) is a soluble species of A $\beta$  present in fluid samples of diseased individuals.

Initially, Applicants note that the instant application and US 6,284,211 (herein after referred to as "the '221 patent") are not commonly assigned. Elan Pharmaceuticals, Inc. is one of the three assignees for the '221 patent, whereas Elan Pharmaceuticals, Inc. is the *sole* assignee of the instant application.

Without acquiescing in the merits of the rejection, it is respectfully submitted that the Suzuki reference is not citable as prior art because Applicants had already reduced to practice at least so much of the invention as is described in this reference. Applicants resubmit herewith a copy of a Declaration Pursuant to 37 C.F.R. §1.131 of Peter A. Seubert, Carmen Vigo-Pelfrey, Dale B. Schenk and Robin Barbour, the individuals named as inventors in the instant application.

This declaration was originally submitted in connection with U.S. Patent Application No. 08/339,141, of whose filing date the instant application claims the benefit. This declaration was also submitted on August 11, 1997 in connection with the instant application. In this declaration, the inventors presented evidence that they invented methods of measuring soluble  $A\beta(x \geq 41)$  before January 1994. By contrast Suzuki *et al.* indicates a publication date of May 27, 1994. Because the inventors invented methods of measuring  $A\beta(x \geq 41)$  before the indicated publication date of Suzuki *et al.*, that reference is not citable under 35 U.S.C. § 103(a) or for double patenting in which a similar analysis applies. Accordingly, Applicants respectfully request the withdrawal of this rejection.

#### Claim Objections

##### U.S. Patent Applications 07/965,972 and 08/079,511

The Examiner alleges that the Applicants have not complied with one or more conditions for receiving the benefit of an earlier filing date under 30 U.S.C. 120 because the specification does not specifically state the relationship between the applications (07/965,972; 08/079,511) and neither application provides written description support for the new claimed matter.

The Examiner may have overlooked that the specification was amended on February 16, 2005 to remove the previous priority claim to U.S. Patent Applications Nos. 07/965,972 and 08/079,511. If this amendment has not been entered, the Examiner is requested to so inform applicants.

Applicants have in this amendment further amended the specification by reintroducing a reference and incorporation by reference of related U.S. Patent Application Nos. 07/965,972, now abandoned and 08/079,511, now U.S. Patent No. 5,593,846 to the end of the background section. However, applicants do not intend to claim priority to these applications.

Claim 48

Claim 48 has been amended as suggested by the Examiner.


35 U.S.C. §103(a)

Claim 42-45, 48 and 51-54 stand rejected as allegedly obvious over Schenk *et al.*, US 6,284,221 in view of Vigo-Pelfrey *et al.* and Suzuki *et al.* The Examiner alleges that it would have been *prima facie* obvious to modify the assay of US 6,284,211 by measuring the species of A $\beta$ (x $\geq$  41) by means of the assay of Suzuki *et al.* because Vigo-Pelfrey *et al.* teach that A $\beta$ (1-42) is a soluble species of amyloid beta in cerebrospinal fluid samples of affected individuals.

Without acquiescing in the merits of the rejection, Applicants traverse the rejection under 35 U.S.C. §103(a) for the same reasons as stated under the obviousness double patenting rejection section. Therefore, in light of the remarks, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 103(a).

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

  
Eureka Wang  
Reg. No. 50,510

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 650-326-2400  
Fax: 415-576-0300  
Attachments  
JOL:YEW:yew  
61148955 v1